

REMARKS

Entry of the foregoing, reexamination and further and favorable reconsideration of the subject application in light of the following remarks, pursuant to and consistent with 37 C.F.R. § 1.112, are respectfully requested.

By the foregoing amendment, claims 1-2, 11, 14, 30-34, 38-39, 42-43, 54, 67-68 and 72-73 have been amended. In particular, claims 1, 11 and 34 have been amended to recite "wherein said microorganism is *Mortierella alpina* SAM 2241 or *Mortierella alpine* SAM2242" Support for this amendment can be found on at least page 12, line 33 through page 13, line 4. Additionally, claims 2, 14, 30-33, 38-39 42-43, 67-68 and 72-73 have been amended to insert a comma at various locations in accordance with the Examiner's suggestions. Claims 39, 54 and 67-68 have been amended to be dependent upon claim 34. Claims 42 and 43 have been further amended to recite "of" instead of "according to". Lastly, claims 55-56, 65-66 and 71-73 have been canceled without prejudice or disclaimer to the subject matter recited therein. Applicants reserve the right to file one or more continuation application(s) directed to the canceled or amended subject matter. No new matter has been added by the present amendment.

Turning now to the Office Action, the Examiner has indicated that the following objections will be made should certain of the claims be found allowable:

- (1) Claims 2, 7-14, 34 and 37-41 will be objected to as being substantial duplicates of claim 1 "because defining a microorganism in two claims in terms of its characteristics, or how it is made or obtained does not require a different microorganism." See OFFICE ACTION at 2-3.
- (2) Claims 65-68 will be objected to as being substantial duplicates of claims

30-33 because "method [c]laims 65-68 require the same method steps and same microorganism strain as in the method claims 30-34." See OFFICE ACTION at 3.

- (3) Claims 72-73 will be objected to as being substantial duplicates of claims 42-43 because "method [c]laims 72 and 73 require the same method steps as in the method claims 42 and 43." See OFFICE ACTION at 3.

Since there has not been any indication of allowable subject matter as of yet, each of these issues are "future" objections. Applicants will address such issues at the time or in the event such matters become actual objections to the claims.

Claims 2, 14, 30-33, 38-39, 42-43, 66-68 and 71-73 have been objected to for various informalities. See OFFICE ACTION at 3-4. To expedite prosecution in the present application, and not to acquiesce to the Examiner's objections, the objected to claims have been amended so as to render such objections moot. In particular, claims 2, 14, 30-33, 38-39 42-43, 66-68 and 72-73 have been amended to insert a comma at the locations suggested by the Examiner. Additionally, claim 39 has been amended to be dependent upon claim 34 and claims 71-73 have been canceled without prejudice or disclaimer to the subject matter recited therein. In view of the above, withdrawal of these objections to the claims are respectfully requested.

Claims 1-2, 7-14, 30-34, 37-43, 52, 54-58 have been rejected under 35 U.S.C. § 112, second paragraph, as allegedly being indefinite for failing to particularly point out and distinctly claim the subject matter which applicants regard as the invention. See OFFICE ACTION at 4-5. These rejections are respectfully traversed.

Applicants respectfully disagree with the Examiner's allegation that the phrase "isolated microorganism" somehow renders the claims indefinite. The phrase

"isolated microorganism" has been used in claims and allowed by Examiner's in numerous United States Patents. See, e.g., U.S. Patent No. 6,812,020. Moreover, recitation of "isolated microorganism" is to distinguish the claimed subject matter from the natural entity, *i.e.*, non-statutory subject matter. Applicants' believe that "isolated" is enough to distinguish the claimed strains from naturally occurring microorganism. Further, the claimed strain was isolated by, for example, colony isolation. The Examiner's suggestion to recite "a biologically pure isolated microorganism" is unduly limiting, particularly without sufficient proper basis to support the rejection.

The Examiner's argument that dependent claims, such as claims 2 and 37, are indefinite as they do not further limit the base claim from which they depend is not proper. The dependent claims, as admitted by the Examiner, do in fact recite further characteristics of the microorganisms. As such, the dependent claims do properly further limit the base claim from which it depends.

The Examiner has rejected claims 42, 43, 54, 56, 70 and 71 for allegedly lacking antecedent basis.

With regard to claims 42 and 43, the Examiner appears to have been confused in thinking that the microorganism was to be cultured in a manner which is not recited in claim 34. Rather, claims 42 and 43 are simply directed to a method that involves culturing the microorganism "according to" or of claim 34. Therefore, for the Examiner's convenience (and not to acquiesce to the Examiner's rejection), claims 42 and 43 have been amended to recite "of" in place of "according to". These amendments are not intended to limit the scope of either claim or any elements recited therein.

As to claim 54, such claim has been amended to now be dependent on claim 34.

To expedite prosecution in the present application, and not to acquiesce to the Examiner's rejections, claims 56, 70 and 71 have been canceled without prejudice or disclaimer to the subject matter recited therein. Thus, the rejections with respect to these claims have been rendered moot.

In view of the above, the Examiner is respectfully requested to withdraw all of the rejections under 35 U.S.C. § 112, second paragraph.

The Examiner has rejected claims 1, 2, 7-14, 30, 34, 37-42, 52, 54-58, 65-66 and 70-72 under 35 U.S.C. § 102(b) as purportedly being anticipated by Shinmen et al. (EP 0 276 982). See OFFICE ACTION at 5-6. This rejection is respectfully traversed.

For prior art to be anticipatory under section 102, the Federal Circuit has held that every element of the claimed invention must be disclosed in a single item of prior art in the form literally defined in the claim. See, e.g., *Hybritech, Inc. v. Monoclonal Antibodies, Inc.*, 213 U.S.P.Q. 81, 90 (Fed. Cir. 1986).

For prior art to be anticipatory under section 102, the Federal Circuit has held that every element of the claimed invention must be disclosed in a single item of prior art in the form literally defined in the claim. See, e.g., *Hybritech, Inc. v. Monoclonal Antibodies, Inc.*, 213 U.S.P.Q. 81, 90 (Fed. Cir. 1986).

The Shinmen et al. EP publication does not describe, either explicitly or inherently, a mutant which extracellularly secretes an unsaturated fatty acid-containing lipid vesicles. As such, the Shinmen et al. EP publication does not anticipate applicants' claimed invention.

In view of the above, withdrawal of the rejection under 35 U.S.C. § 102(b) is respectfully requested.

Additionally, claims 1-2, 7-14, 30-34, 37-43, 52, 54-58, 65-68 and 70-73 have been rejected under 35 U.S.C. § 103(a) as allegedly being obvious over Shinmen et al. (EP 0 276 982). See OFFICE ACTION at 6-7. This art rejection is also respectfully traversed.

Even in a *prima facie* case of obviousness, the reference (or references when combined) must teach or suggest all of the claim limitations. See M.P.E.P. § 2143. Here, the Examiner has relied solely upon the teachings of the Shinmen et al. EP publication. However, the Shinmen et al. EP publication does not teach or suggest a mutant which extracellularly secretes an unsaturated fatty acid-containing lipid vesicles. As such, the Shinmen et al. EP publication does not teach or suggest all of the claim limitations. Thus, a proper *prima facie* case of obviousness has not been made of record.

In view of the above, withdrawal of the rejection under 35 U.S.C. § 103(a) is respectfully requested.

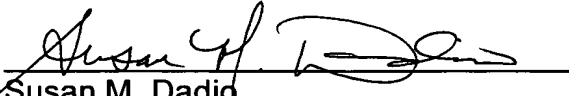
From the foregoing, further and favorable action in the form of a Notice of Allowance is respectfully requested and such action is earnestly solicited.

In the event that there are any questions concerning this Amendment and Reply or the application in general, the Examiner is respectfully requested to telephone the undersigned so that prosecution of the application may be expedited.

Respectfully submitted,

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